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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,240	08/01/2003	Roy Wong	56494US010	2455

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

Application No.

10/633,240

Applicant(s)

WONG, ROY

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-42 is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 1, line 1, update status of cross-reference information. Appropriate correction is required.

Claim Objections

2. Claim 2 is objected to because of the following informalities: line 2, "is" is unnecessary and should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,5,10,11,13,16,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rabuse et al US 3347362.

Rabuse et al teaches coating one or both edge faces (col. 4, 4-6) of rolls of tape by applying a solution of a thin-film forming agent (waxy organic per claim 5, PVA, etc) and solvent (including water, see example, col. 12, 59), and then drying the coated tape (col. 3, 36). The coating prevents static build-up and prevents rough edges upon tearing; the coating materials are inherently non-tacky and therefore would have de-tackified the edges per claim 1. The roll further comprises a backing film, e.g. cellulose acetate (per claim 13) or PVC (per claim 11), and an adhesive, e.g. rubber-resin types per claim 10 (col. 4, 55-57).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Swanson et al WO00/78882.

Rabuse is cited for the same reasons previously discussed, which are incorporated herein. The specific polymer film forming agents of claims 2-4 are not cited. However, Swanson et al teaches binding coatings on tapes which comprise acrylics, vinyl acetate, PVC, polyurethanes, vinyl acetate, etc on page 18, 18-25 and elsewhere. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rabuse et al by incorporating the polymer components of Swanson et al in the coating composition to provide coating materials which bind to fibrous sheet tape materials.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al.

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Rabuse is cited for the same reasons previously discussed, which are incorporated herein. Rabuse discloses the edge coatings to be “of a soft plastic or waxy composition”, without further limitation, thus reasonably suggesting other liquid coating compositions of a soft plastic or waxy composition, encompassing polymeric polyethylene waxes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rabuse et al by incorporating a polyethylene wax edge coating because of the expectation of forming suitable edge coatings, given column 2, 47-66 of Rabuse et al.

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Hawley's.

Rabuse is cited for the same reasons previously discussed, which are incorporated herein. A metal alkyl salt is not cited. However, Hawley's teaches that calcium stearate, defined on page 8 as a metal alkyl salt, is a stabilizer for vinyl resins, and since Rabuse teaches PVA as a film former, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rabuse et al by incorporating calcium stearate alkyl metal salt of Hawley's as a stabilizing agent to form stable compositions for edge coating rolls of PSA tape.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Koshar et al.

Rabuse is cited for the same reasons previously discussed, which are incorporated herein. Koshar et al forms PSA tapes in which it is taught on column 11, 56-56 to use fumed silica as fillers in low surface energy coatings related to the tapes. It is also the Examiner's position that the use of fumed silica is notoriously conventional in coatings to provide a white coloration and/

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or modify rheology. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rabuse et al by incorporating fumed silica filler as taught by Koshar in the edge coating to provide coloration and/ or modification of rheology.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Larimore et al US 4751108.

Rabuse is cited for the same reasons previously discussed, which are incorporated herein. Use of a fiber scrim is not disclosed. Larimore et al teaches forming PSA adhesive tapes wound in roll form having one broad surface which is tack free. Column 4, 40-48 teaches such tapes can be provided with a tissue-like scrim (same as 'fiber scrim') of cellulose, nylon, etc embedded in the adhesive layer to provide greatly enhanced strength and integrity. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rabuse et al by incorporating a fiber scrim within the adhesive layer to provide the advantages of enhanced strength and integrity.

12. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Kantner et al US 5536768.

Rabuse is cited for the same reasons previously discussed, which are incorporated herein. A release liner is not taught.

Kantner et al teaches pressure sensitive adhesive (PSA) medical tapes having a release liner 46 of a type of film known in the art, such as polyethylene terephthalate, which is applied to cover the adhesive layer 44, to prevent unwanted sticking.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rabuse et al by incorporating a release layer as disclosed by

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Kantner et al to provide a roll of edge-coated tape with a release layer to cover the adhesive surfaces to prevent unwanted sticking.

13. Claims 40-42 distinguish over the prior art which does not teach nor suggest edge coating a roll of PSA tape with a hot melt composition to prevent tackification of the edge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571/272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp